

REMARKS

The withdrawal of the several prior art rejections and the obviousness-type double patenting rejection, made in the prior Office Action, is respectfully acknowledged.

The Amendments

Claims 1 and 3 are amended to reflect the language supported by the priority document, DE 10038858.2, filed August 4, 2000. Claim 16 is canceled for this reason also. New claim 17 recites the specific compounds previously in claim 3 which are not literally supported by the priority document but are within the scope of formula I of claim 1.

For the reasons discussed below, the above amendments would put the application in condition for allowance or materially reduce or simplify the issues for appeal. The amendments do not raise new issues or present new matter and do not present additional claims without the cancellation of a corresponding number of finally rejected claims. The amendments have been made to address the new statements of rejection, particularly the denial of claim to priority for the previous claims, and, thus, were not earlier presented. Accordingly, it is submitted that the requested amendments should be entered.

To the extent that the amendments avoid the prior art or for other reasons related to patentability, competitors are warned that the amendments are not intended to and do not limit the scope of equivalents which may be asserted on subject matter outside the literal scope of any patented claims but not anticipated or rendered obvious by the prior art or otherwise unpatentable to applicants. Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Rejections under 35 U.S.C. § 102(e)

The rejections of claims 1, 3-10 and 12-16 under 35 U.S.C. § 102(e), as being anticipated by Heider et al. (US 2002/0001755 A1), Schmidt et al. (US 2002/0012850 A1) or Schmidt et al. (US 2002/0015884 A1), are respectfully traversed.

By the above amendments, claim 1 now recites the language literally supported by the disclosure in the German priority document (as evidenced by the previously submitted verified translation). Dependent claims 3-10 and 12-15 are also directed to subject matter fully supported by the German priority document; note the amendment to claim 3 and cancellation of claim 16. Accordingly, it is urged that claims 1, 3-10 and 12-15 are entitled to the claimed priority date of August 4, 2000. This priority date pre-dates the 102(e) effective date of each of the cited references. Thus, the references are not prior art to these claims.

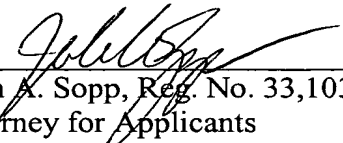
Claim 17 recites specific fluoroalkyl phosphates which fall within the scope of the formula I defined by the priority document but the specific compounds of claim 17 were not specifically recited in the priority document. These compounds are recited in the specification of this U.S. application. Because they fall within the scope of formula I of the priority document, applicants submit that they are entitled to the German priority date and avoid the 35 U.S.C. § 102(e) rejections. Regardless, however, the specific compounds of claim 17 are not anticipated by the disclosures of any of the three cited references. None of these specific compounds is particularly described in an anticipatory manner by any of the references. Thus, even if claim 17 is not entitled to the priority date, it is still not anticipated under 35 U.S.C. § 102(e) by the references. Due to common ownership, these 102(e) references cannot be a basis for an obviousness rejection under 35 U.S.C. § 103; see 35 U.S.C. § 103(c).

For the above reasons, the rejections under 35 U.S.C. § 102(e) should be withdrawn.

It is submitted that the application is in condition for allowance. But the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



John A. Sopp, Reg. No. 33,103
Attorney for Applicants

MILLEN, WHITE, ZELANO &
BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: MERCK-2295

Date: January 21, 2004

K:\Merck\2295\RAF to 8-22-03 OA.doc